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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,509

05/08/2006

Yuji Itoh

127958

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25944 7590 02/12/2008

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ALEXANDRIA, VA 22320-4850

EXAMINER

MORGAN, EILEEN P

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

02/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,509	Applicant(s) ITOH ET AL.	
	Examiner Eileen P. Morgan	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-8-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 4 rejected under 35 U.S.C. 102(b) as being anticipated by Mori-5,569,060.

Mori discloses a method of grinding a cylindrical workpiece by traverse grinding from one end (Ga) to middle (Gb) and traverse grinding from a second end (Gc) to middle (Gb)(Fig. 8)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7,8 rejected under 35 U.S.C. 103(a) as being unpatentable over Mori, alone.

Mori discloses a method of grinding a cylindrical workpiece by traverse grinding from one end (Ga) to middle (Gb) and traverse grinding from a second end (Gc) to middle (Gb)(Fig. 8). Mori does not disclose exact speed or that workpiece is a honeycomb structure. However, the exact grinding wheel speed would have been an obvious design expedient dependent on finish desired. Any known cylindrical

workpiece that can be ground is capable of being ground with the method disclosed by Hayashi.

Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi-5,595,525.

Hayashi discloses a method of grinding an outer surface of a workpiece by plunge grinding and traverse grinding. The grinding method desired is input into computer (Fig. 2c) and the grinding speed (Fig 4) is also input (Col. 4, lines 11-35). Plural grinding steps (plunge and traverse grinding) can be input to be performed on one workpiece(Fig 3). In regard to claim 1, Although Hayashi does not disclose two step grinding comprising plunge grinding workpiece at one location and then traverse grinding from a second location toward first location, it would have been obvious to one of ordinary skill in the art at time invention was made to choose any of the available grinding steps (plunge and traverse) disclosed by Hayashi in any order and direction since these steps are inputted based on grinding and finish desired and the final workpiece finish and diameter would dictate grinding steps. The exact grinding wheel speed would have been an obvious design expedient dependent on finish desired (Fig.4). Any known cylindrical workpiece that can be ground is capable of being ground with the method disclosed by Hayashi.

In regard to claim 4, Although Hayashi does not disclose two step grinding comprising traverse grinding workpiece from one location to middle and then traverse grinding from a second location toward middle, it would have been obvious to one of ordinary skill in the art at time invention was made to choose any of the available

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grinding steps (traverse grinding twice) disclosed by Hayashi in any order and direction since these steps are inputted based on grinding and finish desired and the final workpiece finish and diameter would dictate grinding steps. And the choice of any of these steps would be within the level of ordinary skill. The exact grinding wheel speed would have been an obvious design expedient dependent on finish desired (Fig.4). Any known cylindrical workpiece that can be ground is capable of being ground with the method disclosed by Hayashi.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Monday-Thursday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EM
February 1, 2008

/Eileen P Morgan/
Primary Examiner, Art Unit 3723